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D. REMARKS

Status of Claims

Claims 1-39 are pending in the application. No claims are currently amended.

Double Patenting

The Examiner provisionally rejects claims 1-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/023,407. [Office Action, p. 2] The Examiner states "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same subject matter with minor wording variations." [Office Action, p. 2]

To overcome the provisional obviousness-type double patenting rejection, Applicants file a terminal disclaimer herewith in compliance with 37 CFR 1.321(c) showing that copending Applicants No. 10/023,407 is commonly owned with the present application. In view of the terminal disclaimer, Applicants respectfully request that the Examiner withdraw the provisional obviousness-type double patenting rejection and allow claims 1-39.

Lack of Obviousness under 35 USC § 103(a)

Claims 1-11, 13-23, 25-35, and 37-39 are not obvious under Edwards in view of Katz

Claims 1-11, 13-23, 25-35, and 37-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards et al. (US Patent Number 6,275,940)(hereinafter Edwards) in view of Katz et al. (US Patent Number 2002/0055906)(hereinafter Katz). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that claims 1-11, 13-23, 25-35, and 37-

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39 are not obvious under Edwards in view of Katz and therefore the rejection should be withdrawn and the claims allowed.

Claims 1, 13, and 25

With regards to claims 1, 13, and 25, independent method claim 1, which is representative of independent system claim 13 and independent computer program product claim 25, with regard to similarly recited subject matter and rejection, reads as follows:

1. (Previously Amended) A method for billing for services provided by a caller originating a call, said method comprising:
 - receiving a request to originate a billed transaction for a service provided by a caller from an origin device;
 - authenticating an identity of a callee answering a call originated by said origin device; and
 - responsive to receiving an acceptance of said call by said callee from a destination device, billing an account accessed by said authenticated identity of said callee for a cost of said service and crediting said cost to a caller account to complete said billed transaction when said service provided by said caller is complete, such that said origin device is enabled to initiate said billed transaction charged to said callee for said service provided by said caller to said callee during said call.

In the rejection of claims 1, 13, and 25, the Examiner cites Edwards, col. 3 and cols. 11-13 as disclosing "a method for verifying information during telemarketing information including receiving a request to originate a transaction for a service provided by a caller from an origin device; authenticating an identity of a called party answering the call and responsive to receiving an acceptance of the call by the called party, storing billing information including a telephone number and billing account information." [Office Action, pp. 3, 5, 6] In addition, the Examiner states Edwards discloses that "[a]ccording to (see col. 13), phone bill and data including credit card information can be verified. [Office Action, pp. 3, 5, 6]

In addition, the Examiner states "[I]t is notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription

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service wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed." [Office Action, pp. 3, 5, 6] The Examiner concludes "Edwards fails to teach billing services to an account associated with the service subscribed" but that "Katz teaches a method and apparatus for intelligent selection of goods and services in telephonic and electronic commerce wherein telemarketers can generate an outbound call or receive an inbound call to/from a customer. The interaction between the two parties can result in authorization of an account for the user to whom a service is being provided (see paragraph [0039], [0040], [0048], [0054-0058]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Katz into that of Edwards thus making it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue." [Office Action, pp. 2-3, 5, 6]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not prove a prima facie case of obviousness as to claims 1, 13, and 25, and therefore Applicants respectfully request removal of the rejection and allowance of the claims.

Edwards in view of Katz does not teach or suggest each and every element of claims 1, 13, and 25

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest ALL the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Applicants respectfully assert that claims 1, 13 and 25, when viewed as a whole, teach that an origin device initiates the billed transaction request for a service *provided*

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by the caller at an origin device. Further, Applicants respectfully assert that claims 1, 13 and 25, when viewed as a whole, teach that the service is one that is provided by the caller to the callee *during the call* (claim 1 reads "such that said origin device is enabled to initiate said billed transaction charged to said callee for said service provided by said caller to said callee during said call").

Applicants respectfully assert that a *prima facie* case of obviousness is not established because Edwards and what is "notoriously well known in the art" do not teach the origin device initiating the billed transaction request for a service provided by the caller at the origin device, where the service is one that is provided by the caller to the callee during the call. The Examiner cites Edwards and what is well known in the art as teaching all the elements of claims 1, 13 and 25 except for the Examiner's summary of "billing services to an account associated with the service subscribed." [Office Action, pp. 3, 5, 6] Edwards describes a telemarketer interface system including

"the steps of initiating, by a telemarketer, using the telemarketing user interface, a telephone contact with the customer to request authorization to take a specific action. If the customer authorizes the specified action, the telemarketer directs a plurality of queries to the customer. In response to the plurality of queries, the customer provides a first plurality of responses"

in col. 3, lines 7-13. In addition, Edwards describes generating a text file of the first set of responses and establishing a communication like with a TPV IVR which then prompts the caller for responses to questions and determines whether the answers match the answers in the first set of responses in col. 3, lines 16-40. Edwards describes that the telemarketer requests the callee to authorize a change of long distance service. *Edwards*, col. 11, lines 34-42.

In addition, the Examiner cites that it is "notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription services wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed." [Office Action, pp. 3, 5, 6] Applicants respectfully request that if the Examiner is to continue to maintain the rejection based

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on "what is notoriously well known" that the Examiner provide documentary support for this statement of what is notoriously well known. The Examiner merely states that it is well known to receive calls from telemarketers extending a subscription service for a service provider where a user can pay for services subscribed to, but does not provide any documentary evidence of the well-known nature of the use of telemarketers for extending subscription services. Therefore, Applicants request that if the rejection is to be maintained on these grounds that the Examiner provide documentary evidence of the basis of the assertion of what is well known in the art in the next Office Action. MPEP 2144.03, 37 CFR 1.104(c)(2). *See also Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.)

Regardless of whether the Examiner's assertion as to what is notoriously well known can be properly supported with documentary evidence, Applicants respectfully assert that neither Edwards nor what is "notoriously well known" of a telemarketer selling a callee a subscription service teach a service provided by the caller from the origin device to the callee during the call. The Examiner clearly states that the only service provided by what is "notoriously well known" is a subscription service for future calls, not a service for which a billed transaction is initiated at the origin device for the call and then the service is provided by the caller during the call. Thus, while Applicants assert that the Examiner's definition of services is not well founded in view of claims 1, 13, and 25 as a whole, the Examiner's own support of the misinterpretation shows that Edwards and what is notoriously well known do not teach at least one element of claims 1, 13, and 25.

In addition, Applicants note Katz likewise does not teach the elements of the origin device initiating the billed transaction request for a service provided by the caller at the origin device, where the service is one that is provided by the caller to the callee during the call. The Examiner cites Katz as providing the missing element of "billing services to an account associated with the service subscribed." Applicants continue to assert that the Examiner misinterprets "service" to include subscription services that are

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not provided by the caller during the call itself. In addition, however, Applicants respectfully note that Katz also does not disclose a service provided by the caller to the callee during the call, where the service is the item billed for in the billed transaction. Katz, paragraph 0039 describes that an "[a]pparatus and methods are provided for effecting remote commerce, such as in telemarketing (either inbound or outbound) and in electronic commerce, which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer. In one implementation of the invention, the system and methods obtain input information for the system from a primary transaction, identify one or more goods or services for possible proffer and upsell to the customer based at least in part upon the primary transaction data information provided to the system, and thereafter, offer the user or customer one or more items determined to be among the optimum upsells." Katz provides an example of "service" as "a user initiating remote contact with a source of sales or services might initially contact the source desiring repair of a defective product, whereupon the transaction determination data indicating a repair contact may then be used as an input to the system identifying responses to be proffered." Katz, paragraph 0042. Katz describes goods or services, authorized to be purchased over the telephone, but then shipped separate from the telephone call. Katz, paragraph 0057. Nowhere does Katz describe the origin device initiating the billed transaction request for a service to be provided by the caller at the origin device during the call. Scheduling a repair of a defective product or purchasing a good over the telephone of Katz does not teach the caller performing the billed for service during the call. Therefore, because neither Edwards, what is well known, or Katz, separately or in combination, teach at least one element of claims 1, 13, and 25, a prima facie case of obviousness is not proven and the claims should be allowed.

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In addition, to establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants respectfully assert that there is no reasonable expectation of success in the Examiner's proposed combination of Edwards and what is well known in view of Katz because none of Edwards, what is well known, or Katz teach the billed for service provided by the caller to the callee during the call in which the billed transaction is initiated and authorized. Edwards describes a telemarketer requesting that a callee authorize the telemarketer to perform an action and to enable verification of the authorization the callee answers a first set of questions to the telemarketer, the answers are passed to a second system and the second system prompts the callee with additional questions and compares the answers to the addition question to those of the first set of questions. Edwards, col. 3, lines 7-40. Katz discloses a telemarketing system where based on a primary good or service purchased by a caller, the system identifies other goods or services to offer to the caller, where the goods or services are deliverable or schedulable, but not provided during the call. The Examiner states that the combination of Edwards and Katz would make "it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue." [Office Action, p. 4] Applicants respectfully assert, however, that if anything, the combination of Edwards and Katz discloses making it possible to billed a called party for a subscription service to be delivered in future calls, a good to be delivered, or a service to be performed separate from the call, such as a show repair. Neither Edwards or Katz, or the combination, discloses a service provided during the call by the caller. As a result, the combination of Edwards, what is well known, and Katz cannot establish a prima facie case of obviousness and the rejection of claims 1, 13, and 25 and should be withdrawn.

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Claims 2-11, 14-23, 26-35

Regarding claims 2-11, 14-23, and 26-35, Applicants respectfully propose that because claims 1, 13, and 25 are not obvious under Edwards in view of Katz, as claims dependent upon claims 1, 13, and 25, claims 2-11, 14-23, and 26-35 are not obvious under Edwards in view of Katz and the dependent claims should be allowed.

In addition, Applicants respectfully assert that a prima facie case of obviousness is not established for claims 2, 3, 14, 15, 26, and 27 because Edwards in view of Katz does not teach all the elements of claims 2, 14, and 26. In the rejection of claims 2, 14, and 26, which is also applied to claims 3-5, 15-17, and 27-29, the Examiner states:

The combination renders the claimed subject matter by providing a service only after an account of a user has been verified after which a go ahead can be given to the service provider. [Office Action, pp. 4, 5]

Claim 2, which is representative of dependent system claim 14 and dependent program claim 26 with regard to subject matter and rejection reads:

2. (Previously Amended) The method for billing for telephone services according to claim 1, further comprising:
only prompting said caller to provide said service if said callee is one of a plurality of callees authorized to accept said billed transaction for said service.

Applicants respectfully assert that claims 2, 14, and 26 do not merely teach that a service is provided after an account of a user has been verified and the service provider is given the go ahead, as argued by the Examiner. As clearly indicated in claims 2, 14, and 26, there are only certain callees authorized to accept the billed transaction for the service and the service provider is only prompted to provide the service if the callee is one of these authorized callees. Thus, claims 2, 14, and 26 do not merely describe that a callee account is verified, but also that a determination is made whether the callee is one who is marked as one who can accept the service. Neither Edwards nor Katz describes that there is a specific group of callees authorized to accept the service. Therefore, because the combination of Edwards and Katz does not teach prompting based on whether the callee is one of the certain callees authorized to accept the

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service, the combination does not teach all the elements of claims 2, 14, and 26 and the claims should be allowed.

Claim 3, which is representative of dependent system claim 15 and dependent program claim 27 with regard to subject matter and rejection reads:

3. (Previously Amended) The method for billing for services according to claim 1, further comprising:
responsive to receiving said request to originate said billed transaction at a switch within a trusted telephone network providing a telephone service connection for said call, establishing a secure communication channel between a billing service provider outside said trusted telephone network and said trusted telephone network, wherein said billing service provider controls authenticating said identity of said callee answering said call, prompting said callee to accept said call with said service, accessing said account by said authenticated identity of said callee, and controlling billing said account accessed by said authenticated identity of said callee for said cost of said service and crediting said cost to said caller account to complete said billed transaction.

Applicants respectfully assert that claims 3, 15, and 27 do not merely teach that a service is provided after an account of a user has been verified and the service provider is given the go ahead, as argued by the Examiner. As clearly taught in claims 3, 15, and 27, a secure communication channel is established between a billing service provider outside a trusted telephone network and the switch with the trusted telephone network, where the billing service provider outside the trusted telephone network handles authenticating the callee identity, prompting the callee to accept the call with the service, accessing an account by the authenticated identity of the callee and controlling billing of the account for the cost of the service. The Examiner does not point to any teaching within Edwards or Katz or the combination, nor do Edwards or Katz disclose any teaching of a billing service provider outside the trusted telephone network handling callee identity authentication, prompting the callee for accepting a call with the service, accessing a callee account and charging the cost of the service to the callee account. Therefore, because the combination of Edwards and Katz does not teach all the elements of claims 3, 15, and 27 the claims should be allowed.

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Claim 4, which is representative of dependent system claim 16 and dependent program claim 28 with regard to subject matter and rejection reads:

4.(Previously Amended) The method for billing for telephone according to claim 1, further comprising:
prompting said callee to accept said call and incur a charge for said cost indicated in said billed transaction; and
only completing said billed transaction if said callee accepts said call.

Applicants respectfully assert that claims 4, 16, and 28 do not merely teach that a service is provided after an account of a user has been verified and the service provider is given the go ahead, as argued by the Examiner. As clearly taught in claims 4, 16, and 28, the callee is prompted to accept the call and incur a charge for the cost indicated in the billed transaction. Both Edwards and Katz only disclose a callee authorizing a change of long distance service or authorizing a charge for a good or service to be provided separate from the call. When claims 4, 16, and 28 are viewed as a whole with claims 1, 13, and 25, it is clear that the callee is prompted to accept the call and thus to accept the charge for a cost of the service to be provided during the call. Neither Edwards nor Katz teaches a callee being prompted to accept the call itself and by accepting the call, accepting the charge for the cost of the service to be provided during the call. Therefore, because the combination of Edwards and Katz does not teach prompting the callee to accept the call, all the elements of claims 4, 16, and 28 are not taught and the claims should be allowed.

In addition, Applicants respectfully assert that a prima facie case of obviousness is not established for claims 6, 18, and 30 because Edwards in view of Katz does not teach all the elements of claims 6, 18, and 30. In the rejection of claims 6, 18, and 30, the Examiner states:

The Examiner takes official notice that it's well known to receive calls from vendors or sale calls for purchase of a product wherein a called party can be notified of a product being sold and for how much. Transmission of caller ID is known when available. [Office Action, pp. 4, 5]

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Claim 6, which is representative of dependent system claim 18 and dependent program claim 30 with regard to subject matter and rejection reads:

6.(Previously Amended) The method for billing for services according to claim 1, further comprising:
 authenticating an identity of said caller utilizing said origin device;
and
 providing said callee with said identity of said caller.

First, Applicants respectfully request that if the Examiner is to continue to maintain the rejection based on "what is known" that the Examiner provide documentary support for this statement of what is "known when available". The Examiner merely states that transmission of caller ID is known when available, but does not provide any documentary evidence of the well-known nature of the use of telemarketers for extending subscription services. Therefore, Applicants request that if the rejection is to be maintained on these grounds that the Examiner provide documentary evidence of the basis of the assertion of what is well known in the art in the next Office Action. MPEP 2144.03, 37 CFR 1.104(c)(2). *See also Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.)

Regardless of whether the Examiner's rejection can be supported by proper document evidence, Applicants respectfully assert that claim 6 does not merely describe transmission of caller ID. In particular, claims 6, 18, and 30 clearly teach that the identity of the caller is authenticated and that the caller is provided with the identity of the callee. A caller ID only indicates the subscriber name associated with a telephone number assigned to an origin device. A caller ID does not provide the callee with the identity of the caller. In addition, a caller ID is not authenticated, where authentication requires verification of the identity of the caller, not merely identification of the line from which the call is placed. Further, Applicants note that both Edwards and Katz disclose a telemarketing system context; in contrast the present application includes contexts including allowing any caller from any telephone device to initiate a billed transaction for a service to be provided by the caller, where providing the callee

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with a verified identity of the caller is important to enable the callee to determine whether the actual caller is someone the caller wants to receive a call based service from. Therefore, because the combination of Edwards and Katz does not teach all the elements of claims 6, 18, and 30 the claims should be allowed.

Claims 37-39

Claims 37-39 currently read as follows:

37. (Previously Amended) A method for controlling a billed transaction, comprising:

transferring a call to a destination device with a billed transaction request initiated by a caller placing said call to said destination device , wherein said billed transaction request is for a callee answering said call at said destination device to pay said caller for a service provided by said caller during said call;

authenticating an identity of said callee answering said call at said destination device; and

executing said billed transaction according to a billing plan for said authenticated callee identity.

38. (Original) The method for controlling a billed transaction according to claim 37, further comprising:

only executing said billed transaction responsive to an authorization by said callee.

39. (Previously Amended) A method for controlling callee billing, comprising:

receiving a call at a destination device with a billed transaction request initiated by a caller placing said call, wherein said billed transaction request is for a callee answering said call at said destination device to pay said caller for a service provided by said caller during said call; and

responsive to an acceptance of said billed transaction request by a callee answering said call at said destination device, transferring an authorization to charge a billing plan accessed according to an authenticated identity of said callee.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest ALL the claim limitations. *In re Vaeck*, 947

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F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

The Examiner presents the same grounds of rejection of claims 37 and 39 as are presented with respect to claims 1, 13, and 25. Applicants respectfully assert that as with the rejection of claims 1, 13, and 25, when claims 37 and 39 are interpreted as a whole, the service is provided by the caller and the billed for service is provided during the call. For the same reasons that Edwards and Katz, separately or in combination, do not teach or suggest managing a billed transaction for a service provided by the caller where the service is provided during the call with respect to claims 1, 13, and 25, Edwards and Katz also do not teach the element in claims 37 and 39 of "to pay said caller for a service provided by said caller during said call."

In addition, with regards to claims 37 and 39, the Examiner does not show, nor does the combination of Edwards and Katz teach *a billed transaction request for a callee answering said call at said destination device to pay said caller for a service provided by said caller during said call*. When claims 37 and 39 are viewed as a whole, it is clear that the billed transaction request is for the callee answering the call to accept the charge for a cost of the service to be provided during the call. Both Edwards and Katz only disclose a callee authorizing a change of long distance service for future calls or authorizing a charge for a good or service to be provided separate from the call. Neither Edwards nor Katz teaches transferring to a destination device or receiving at a destination device a billing transaction request that requests the callee to accept to pay the caller for a service to be provided during the call.

Therefore, because neither Edwards, what is well known, or Katz, separately or in combination, teach at least one element of claims 37 and 39, a prima facie case of obviousness is not proven and the claims should be allowed. In addition, because claim
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38 is dependent upon claim 37, which should be allowed, dependent claim 38 should also be allowed as dependent upon an allowable base claim.

Allowable Subject Matter

Applicants note the Examiner's objection to claims 12, 24, and 36 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully request, in view of the foregoing, that a prima facie case of obviousness is not established for base claims 1, 13, and 25 and therefore not only are claims 12, 24, and 36 allowable, but claims 1, 13, and 25 should be allowed.

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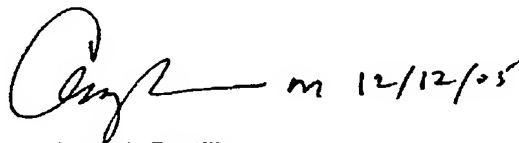
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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Amy J. Pattillo', followed by the date 'm 12/12/05'.

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